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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,986	06/30/2003	Eugenio Cruz	5724.016.20-US	9867

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/607,986	CRUZ, EUGENIO	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/28/06, Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The rejection of claim 1 under 35 USC 102(b) as being anticipated by Giertz et al. (WO 97/31775), as set forth in paragraph 6 of the previous action, has been withdrawn in light of the present amendment; note Giertz teaches a press plate having a 3D surface but this press plate is placed on top of the resin soaked decorative sheet and board to form an assembly which is then placed into a press machine where heating and pressing takes place.
2. The rejection of claim 2 under 35 USC 103(a) as being unpatentable over Giertz et al., as set forth in paragraph 8 of the previous action, has been withdrawn in light of the present amendment; note comments made above regarding the Giertz reference.

Specification

3. The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

As set forth in paragraph 4 of the previous action, the present specification does not have proper antecedent basis for the limitations in original claim 12. Applicant should amend the specification to include these limitations.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 5-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US 2002/0100231).

With respect to claim 1, Miller teaches a method of fabricating a product comprising locating a resin soaked sheet 14 having a decorative motif on a board 16 (Figure 3, sections [0020-0023]), placing the resin soaked sheet and board into a press machine (not shown) having a press plate with a 3D surface (not shown) while the press plate is in a raised position (section [0035]), curing the resin at a predetermined temperature while pressing the resin soaked sheet and board with the press plate at a predetermined pressure such that a laminated product is produced (section [0035]), wherein placing of the resin soaked sheet and board into the press machine aligns the decorative motif of the resin soaked sheet with the 3D surface of the press plate and wherein the produced laminated product has a surface texture that is embossed in registration with the decorative motif (Figure 1B, sections [0009, 0029, 0040]).

Regarding claims 5-7, Miller teaches such (section [0035]; teaches $350-400^{\circ}\text{F} = 176-204^{\circ}\text{C}$, $380-420\text{ psi} = 27-30\text{ kg/cm}^2$, and 18-60 seconds).

Regarding claims 8-9, Miller teaches protective resin-impregnated wear layer 12 located on top of the resin soaked sheet 14 (Figure 3; sections [0024-0026]).

Regarding claims 10-11, Miller teaches a resin-impregnated base layer 24 located under the board 16 (Figure 3; sections [0020-0021]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. as applied to claim 1 above and further in view of Hunter et al. (US 5413834, of record).

Regarding claim 4, Miller is unclear as to milling a hollow in the surface of the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to mill a hollow in the bottom surface of the board of Miller because it is known in the art to mill a hollow in the surface of a board opposite that having a resin soaked decorative paper layer thereon where this imparts flexibility in the form of bending capabilities to the laminate, as taught by Hunter (column 1, lines 64-68; column 2, lines 4-12; column 5, lines 45-53; column 6, lines 8-13).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. as applied to claim 10 above and further in view of Cannady et al. (US 3648358, of record).

Regarding claim 12, Miller teaches the resin soaked decorative sheet being a paper layer impregnated with a thermosetting resin (section [0023]) but is unclear as to a type of paper and thermosetting resin. Selection of a particular paper and thermosetting resin would have been within purview of one having ordinary skill in the art depending on the desired characteristics thereof. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kraft paper impregnated with thermosetting melamine resin because it is known in the art to impregnate Kraft paper with such a thermosetting resin and use it for a decorative sheet in a decorative laminate, as taught by Cannady (column 3, lines 27-36).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-12 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,638,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '387 patent encompass the limitations set forth in the claims of the present application.

Allowable Subject Matter

11. The following is a statement of reasons for the indication of allowable subject matter:

Upon filing a proper terminal disclaimer to overcome the obviousness-type double patenting rejection set forth in paragraph 10 above, claim 2 will be allowable because the prior art fails to teach or suggest milling reference edges on the board and locating the resin soaked sheet on the board relative to the milled reference edges of the board such that the decorative

motif assumes a predetermined position on the board relative to the reference edges and a predetermined position relative to the three dimensional surface of the press plate. It is noted that claim 3 depends from claim 2.

Response to Arguments

12. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JESSICA ROSSI
PRIMARY EXAMINER

Jessica Rossi